REMARKS

Reconsideration and withdrawal of the rejections to this application are respectfully requested in view of the following remarks, which place the application into condition for allowance.

This application relates to, *inter alia*, silencers for muffling the exhaust noise of internal combustion engines. One of the unique features of the instantly claimed invention is modularity. More specifically, the present invention provides for an exhaust silencer with a gas-conducting, perforated pipe selected from a plurality of gas-conducting, perforated pipes with different damping characteristics.

Claims 8-12 are pending. Claim 8 is amended, without prejudice, to advance prosecution. The amendment and the remarks made herein are not made for reasons related to patentability and, thus, do not prevent the application of the doctrine of equivalents. Support for the amended recitation in claim 8 is found throughout the specification.

No new matter has been added.

Claims 1 (*sic*, the Examiner presumably intended to reject claim 8) and 12 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. Claim 12 was also rejected under 35 U.S.C. §101 for allegedly reciting a use without setting forth the steps involved. The rejections will be collectively addressed and are respectfully traversed.

The amendment to claim 8 for purposes of clarity renders the rejection against claim 8 moot. Turning to the Section 112 and 101 rejections to claim 12, Applicants respectfully disagree with the Examiner's reasoning. Contrary to the Examiner's contentions, claim 12 does not recite a "use." Instead, claim 12 recites the positive step of using the exhaust silencer of claim 8 in a method for silencing an exhaust installation of a motor vehicle. Consequently,

reconsideration and withdrawal of the Section 112, second paragraph, and Section 101 rejections are respectfully requested.

Claims 8-12 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,332,873 to Kullander et al. ("Kullander") in view of U.S. Patent 4,880,078 to Inoue et al. ("Inoue") and U.S. Patent No. 3,993,160 to Rauch ("Rauch."). The rejection is traversed. Neither Kullander, Inoue nor Rauch, either alone or in combination, teach, suggest, or motivate a skilled artisan to practice the instantly claimed invention.

In order to ground an obviousness rejection, there must be some teaching which would have provided the necessary incentive or motivation for modifying the reference's teaching. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (B.P.A.I. 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine,* 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Against this background, the requisite teaching, suggestion or motivation is lacking in the Kullander, Inoue and Rauch patents, thereby rendering the obviousness rejection defective. Kullander relates to an exhaust silencer having an exhaust conduit inside a housing. As the Examiner concedes, Kullander does not teach or suggest a modularly designed gas-conducting pipe. By contrast, however, the instantly claimed invention is configured by a modular series of

modular parts which tune the silencer, e.g., by choosing different openings in the same silencer housing. Further, the instant silencer housing serves as a standard structure, wherein the conducting parts can be advantageously exchanged to, for example, adapt the silencer to different operation modes of the combustion engine. Kullander does not teach or suggest such an invention.

Inoue does not remedy the inherent deficiencies in Kullander. Inoue relates to a muffler connected to an exhaust outlet of an internal combustion engine. The muffler has a plurality of component units connected in series, each of said components consisting of a connector pipe surrounded by a suppression chamber. Inoue, however, fails to motivate a skilled artisan to combine its teachings with that of Kullander in order to practice Applicants' invention. For example, Inoue fails to teach or suggest a silencer having a modular structure with the advantage of being able to tune the silencer by, for example, choosing different opening characteristics in the same silencer housing. Further, there is no teaching or suggestion in Inoue of a silencer with modular parts, wherein the modular parts are exchangeable to tune the silencer in accordance with a standard chamber volume. Thus, the Kullander-Inoue combination fails to teach or suggest the instant invention.

Rauch is equally defective. Rauch relates to an exhaust silencer. Contrary to the instant invention, however, the Rauch silencer has a closed case and at least two perforated tubes extending substantially parallel to each other and in a straight line. Rauch does not teach, suggest or motivate a skilled artisan to practice the instant exhaust silencer having a gas-conducting pipe having openings of a defined cross-section and defined wall height, arranged in a silencer housing in such a manner that it runs through an axial series of silencer housing chambers insulated gastight from each other, into which the openings of the gas-

conducting pipe communicatively open, whereby the volumes of all chambers of the silencer housing in connection with the defined openings specifications of all openings of the openings of the pipe communicatively aligned with the respective silencer housing chamber are tunable to an interference frequency band from the noise spectrum of the exhaust gases to be dampened respectively, and the gas-conducting pipe can be led through the silencer housing chambers in such a manner that the latter run through each of the silencer housing chambers at least twice, with minimal dissipation losses, wherein the gas-conducting pipe is constructed as a modular part for a two-part silencer housing, and the modular part of a modular series of modular parts is configured with different openings characteristics, tuned to the same respective silencer housing chamber volumes.

Applicants respectfully reiterate that the combination of Kullander, Inoue and Rauch do not teach or suggest modularity. More specifically, and in contrast to Applicants' invention, none of the cited documents provide for an exhaust silencer with a gas-conducting, perforated pipe selected from a plurality of gas-conducting, perforated pipes with different damping characteristics.

Further, the Examiner is respectfully reminded that "obvious to try" is not the standard by which an obviousness rejection should be based. And as "obvious to try" would be the only standard that would give the instant Section 103 rejections credence, the rejections must fail as a matter of law.

Accordingly, reconsideration and withdrawal of the Section 103 rejection based on the preceding documents are respectfully requested.

In view of the above remarks, it is respectfully submitted that this application is now in condition for allowance. Favorable consideration of the claims is earnestly solicited. If,

however, there is still an outstanding issue, the Examiner is urged to contact the undersigned for its prompt attention.

Respectfully submitted,

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